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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/863,897
Filing Date: May 23, 2001
Appellant(s): KARRI, ET AL

JAMES A. RETTER (#41,266)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 11, 2006 appealing from the Office action mailed November 16, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,859,973	CARPENTER, ET AL	01-1999
6,353,892	SCHREIBER	03-2002
6, 665, 522	LUNDSTROM, ET AL	12-2003

6,597,918	KIM	7-2003
6,792,450	WAKATSUKI	9-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

{A} Claims 1, 11, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kim** in view of **Wakatsuki** and **Carpenter, et al.**

Regarding claim 1, Kim discloses a method for use in conveying a plurality of messages from a sending terminal to a receiving terminal over a telecommunications system that is at least in part a wireless telecommunications system (abstract, fig. 1, col. 1 lines 24-31), the method comprising:

- a) the sending terminal assembling the plurality of messages in a desired order according to inputs by a User (col. 1 line 49 thru col. 2 line 34),
- b) the sending terminal indicating in each message the order of the message in the desired order (fig. 1-3, col. 3 line 7 thru col. 4 line 34);
- c) the sending terminal sending (transmitting) all of the messages to the receiving terminal in response to an input by the user (col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34);

wherein the plurality of messages conveys a plurality of frames so that each frame conveys one or more of the messages, and wherein each frame is logically related to at least one other of the frames (when there is limited length of

message in each frame for the long message, the long message needs more than one frame which means there are a plurality of messages conveys a plurality of frames) (col. 1 lines 32-45, and col. 2 line 61 thru col. 3 line 43).

Regarding claim 11, Kim discloses an apparatus for use by a sending terminal in conveying a plurality of messages to a receiving terminal via a wireless communications network (abstract, fig. 1 col. 1 lines 24-31), the apparatus comprising:

a) means for assembling the plurality of messages in a desired order according to inputs by a user (col. 1 line 49 thru col. 2 line 34)

b) means for indicating in each message the order of the message in the desired order (fig. 1-3, col. 3 line 7 thru col. 4 line 34);

d) means for sending (transmitting) all of the messages to the receiving terminal in response to an input by the user (col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34);

wherein the plurality of messages conveys a plurality of frames so that each frame conveys one or more of the messages, and wherein each frame is logically related to at least one other of the frames (when there is limited length of message in each frame for the long message, the long message needs more than one frame which means there are a plurality of messages conveys a plurality of frames) (col. 1 lines 32-45, and col. 2 line 61 thru col. 3 line 43).

Regarding claim 24. Kim disclose a system comprising:

a) a sending terminal, adapted for conveying to a receiving terminal via a wireless communications network a plurality of messages, and including in each message ordering information indicating a position for the message in a desired ordering of the plurality of messages (fig. 1-2 col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34); and

b) the receiving terminal, adapted for receiving the plurality of messages and ordering the message in the desired order as indicated by the ordering information (fig. 1-2, col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34).

Kim disclose all subject matter except for the plurality of frames to be frames of a funny and of the sending terminal assembling the plurality of messages in a desired order according to inputs by a user. Applicant admits on page 2 of the specification that it is well known in the art to download actual comic strips from wireless application protocol sites. **Wakatsuki** teaches the use of a plurality of frames to be frames of a funny (note figures 7a-7c) in a method and apparatus for use conveying a plurality of messages from a sending terminal for the purpose of displaying a frame of a comic strip (funny) on the display one by one in the order set. Hence, it would have been obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the well known use, as admitted by applicant, for the plurality of frames to be frames of a funny, as taught by **Wakatsuki** for the purpose of displaying a frame of a comic strip (funny) on the display one by one in the order set, in the a method and

apparatus for use conveying a plurality of messages from a sending terminal of **Kim** in order to sequentially display frames of comic strips or funnies.

Carpenter, et al teaches the use of the sending terminal assembling the plurality of messages in a desired order according to inputs by a user (column 7, lines 10-25 in a method for conveying a plurality of messages for the purpose of the user to prioritized and reorders what messages to be sent. Hence, it would have been obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of the sending terminal assembling the plurality of messages in a desired order according to inputs by a user as taught by **Carpenter, et al**, for the purpose of the user to prioritized and reorder what messages to be sent, in the method of conveying a plurality of messages of **Kim** in order to transmit the messages in the order that they were required by the user.

{B} Claims 2, 4-8, 12-18, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kim** in view of **Wakatsuki** and **Carpenter, et al** and in further view of **Shiimori**.

Regarding claim 2, **Kim** further discloses the method of claim 1, further comprising the sending terminal associating with a frame of the plurality of frames is displayed (cal. 1 line 53 thru col. 2 line 3, and col. 2 line 61 thru col. 3 line 5). However, **Kim** does not specifically disclose a special effect to be performed when the frame is displayed.

Shiimori teaches the sending terminal associating with a frame of the plurality of frames a special effect to be performed when the frame is displayed (fig. 4, col. 7 line 38 thru col. 8 line 25). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the **Kim** system with the teaching of **Shiimori** of a special effect to be performed when the frame is displayed in order to make the message or picture more exciting to see.

Regarding claim 4, **Kim** does not specifically disclose the method of claim 2, wherein the special effect is selected from the group comprising vibrating the frame, providing a sound when the frame is first displayed, providing a sound when the frame is closed, opening the frame in stages, and closing the frame in stages.

Shiimori teaches the special effect is selected from the group consisting of vibrating the frame providing a sound when the frame is first displayed, providing a sound when the frame is closed, opening the frame in stages, and closing the frame in stages (fig. 1D, col. 10 line 45 thru col. 12 line 28). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Kim** system with the teaching of **Shiimori** of special effect in order to make the message more special to the recipient.

Regarding claim 5, **Kim** further disclose the method of claim 1, further comprising the sending terminal preparing a frame of the plurality of frames by indicating messages to be displayed in the frame (fig. 1, col. 2 line 64 thru col. 3 line 43). However, **Kim** does not specifically disclose a picture and text to be displayed in the frame.

Shiimori teaches a picture to be displayed in the frame and/or by providing text

to be displayed in the frame (col. 1 line 53 thru col. 3 line 53). Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of **Shiimori** of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 6, **Kim** further discloses the method of claim 1, further comprising the sending terminal. However, **Kim** does not specifically disclose the sending terminal downloading from a service an already-created message and editing the text of a frame of the plurality of frames to personalize the plurality of frames for an assumed operator of the receiving terminal,

Shiimori teaches the method of claim 1, further comprising the sending terminal downloading from a service an already-created message and editing the text of a frame of the plurality of frames to personalize the plurality of frames for an assumed operator of the receiving terminal (fig. 4, 12-14, col. 7 lines 11 -25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of **Shiimori** of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 7, **Kim** further discloses the method of claim 1 further comprising the sending terminal, However, Kim does not specifically disclose the sending terminal downloading from a service or retrieving from stored memory an already-created picture for use as the picture of a frame of the plurality of frames and optional providing text to be associated with the picture,

Shiimori further discloses the method of claim 1, further comprising the sending

terminal downloading from a service or retrieving from stored memory an already-created picture for use as the picture of a frame of the plurality of frames and optionally providing text to be associated with the picture (fig. 4-6, 12-14, col. 7 lines 11-25).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of **Shiimori** of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 8, **Kim** further discloses the method of claim 1, wherein the plurality of frames is provided using a pre-existing message service selected from the group comprising short message service (SMS), extended message service (EMS) and multimedia messaging service (MMS) (abstract, col. 1 line 49 thru col. 2 line 28).

Regarding claim 12, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 13, **Shiimori** further discloses the method of claim 12, further comprising means for reviewing properties of a frame of the plurality of frames, including whether or not a special effect has been associated with the frame (col. 16 line 14).

Regarding claim 14, this claim is rejected for the same reason as set forth in claim 4,

Regarding claim 15, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 16, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 17, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 8.

Kim further discloses a system according to claim 24, further comprising a server wireless coupled to the sending terminal and the receiving terminal (figure 1, #140, column 1, lines 24-46 and column 3, lines 11-43). However, **Kim** does not specifically disclose a server providing a picture to either the sending terminal or receiving terminal in response to a request for the picture from either the sending terminal or the receiving terminal.

Shiimori teaches a server providing a picture to either the sending receiving terminal in response to a request for the picture from either the terminal or the receiving terminal (abstract, #3e fig. 1, col. 6 lines 29-51), therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the **Kim** system with the teaching of **Shiimori** of a server providing a picture to sending or receiving terminal in order to allow the user to receiving the picture to edit it with personal message,

Regarding claim 22, **Shiimori** further discloses the system of claim 21 wherein the server for providing a picture in response to a request for the picture does so in response to a bookmark (image) communicated by the receiving terminal according to the a wireless application protocol (abstract, #30 fig. 1 col. 6 lines 29-51).

Regarding claim 23, **Shiimori** further discloses the system of claim 21, wherein

the server for providing a picture in response to a request for the picture does so in response to request communicated by the sending terminal! thereby making available the picture for use by the sending terminal in composing (editing) one or more of the plurality of messages (fig. 3-4, 9-10, 12-14! col. 6 line 29 thru col. 10 line 39).

{C} Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kim** in view of **Wakatsuki** and **Carpenter, et al** and in further view of in view of **Lundstrom et al**.

Regarding claim 9, **Kim** further discloses the method of claim 1, wherein the plurality of frames, However, **Kim** does not specifically disclose the plurality of frames consists of three ordered frames, each frame comprising a picture and associated text personalized for an intended recipient.

Lundstrom et al. teaches the plurality of frames consists of three ordered frames, each frame comprising a picture and associated text personalized for an intended recipient (col. 5 lines 1-48). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify **Kim** system with the teaching of **Lundstrom et al**, of three ordered frame in order to provide the receiver device to determine the number of frames it must receive in order to receive the complete message.

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 9,

{D} Claims 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kim** in view of **Wakatsuki** and **Carpenter, et al** and in further view of in view of **Schreiber et al.**

Regarding claim 10, **Kim** further discloses the method of claim 1. However, **Kim** does not specifically disclose, wherein the plurality of frames is protected from being copied using a form of protection selected from the group comprising: copy protection, digital rights management, and encryption.

Schreiber et al, teaches the frame is protected from being copied using a form of protection selected from the group comprising: copy protection, digital rights management, and encryption (title, col, 18 lines 22-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Kim** system with the teaching of **Schreiber et al.** of copy protection in order to protect personal information from unauthorized recipient.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 10.

(10) Response to Argument

In response to arguments on pages 11 and 16, during examination before the Patent and Trademark Office, claims must be given their broadest reasonable interpretation and limitations from the specification may not be imputed to the claims (Ex parte Akamatsu, 22 USPQ2d, 1918; In re Zletz, 13 USPQ2d 1320, In re Priest, 199 USPQ 11). Clear inference to the artisan must be considered, In re Preda, 159 USPQ 342. A prior art reference must be considered together with the knowledge of one of ordinary skill in the pertinent art, In re Samour, 197 USPQ 1. During patent examination, the pending claims must be "*given the broadest reasonable interpretation consistent with the specification.*" Claim term is not limited to single embodiment disclosed in specification, since number of embodiments disclosed does not determine meaning of the claim term, and applicant cannot overcome "*heavy presumption*" that term takes on its ordinary meaning simply by pointing to preferred embodiment (Teleflex Inc. v. Ficosa North America Corp., CA FC, 6/21/02, 63 USPQ2d 1374). Appellant had the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA1969). Logically means:

1. according to or agreeing with the principles of logic: *a logical inference.*
2. reasoning in accordance with the principles of logic, as a person or the mind: *logical thinking.*

3. reasonable; to be expected: *War was the logical consequence of such threats.*
4. of or pertaining to logic.

Related means:

1. to tell; give an account of (an event, circumstance, etc.).
2. to bring into or establish association, connection, or relation: *to relate events to probable causes.*
-verb (used without object)
3. to have reference (often fol. by *to*).
4. to have some relation (often fol. by *to*).
5. to establish a social or sympathetic relationship with a person or thing: *two sisters unable to relate to each other.*

Clearly **Kim** shows this. Kim shows sending to a receiving terminal a plurality of **reasonable and to be expected and to have some relation** frames. Appellant is arguing that **Kim** can only and ever send one frame and that is it, Kim would never work again. Each frame has **reasonable and to be expected and to have some relation** of "*a header information having a long message identification (ID) and a divided message sequence information of the divided shorter messages,*" is one example.

If appellant uses such broad terms then, appellant should not surprise that the examiner also examines the claimed invention just as broadly.

In response to arguments on page 13, Appellant is arguing that **Kim** cannot be ever modify. In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness

can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious for one of ordinary skill in the art at the time the claimed invention was made to incorporate the use of the sending terminal assembling the plurality of messages in a desired order according to inputs by a user as taught by **Carpenter, et al**, **for the purpose of the user to prioritized and reorder what messages to be sent**, in the method of conveying a plurality of messages of **Kim in order to transmit the messages in the order that they were required by the user**.

In response to Appellant's arguments on page 14, against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to appellant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., telephonic communication) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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